

REMARKS

Claims 56-63 were rejected under 35 USC 102(b) as being anticipated by Park et al. (Society for Biomaterials article). Although average pore sizes are not mentioned for the materials disclosed by the cited reference, the Action deems that the disclosed materials inherently possess the recited average pore size range due to similarities in materials and work-up.

Contrary to the Examiner's assertion, the referenced materials and methods of production do not necessarily afford hydrogel foams having an average pore size in the range of 10 to 3000  $\mu\text{m}$ , as recited for the claimed hydrogel foams. As noted in the cited article, the observed swelling ratios depend a great deal on the type of monomer employed, the amount of surfactant used, the timing of addition of foaming agent to the polymerizing mix, among other parameters. Likewise, the average pore sizes possessed by the disclosed materials can be expected to depend heavily on such parameters - even to the extent of being outside the recited range.

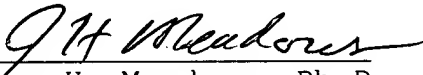
As noted at MPEP 2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," citing *In re Rijckaert*, 9 F.3d 1531, 1534; 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Moreover, "[i]n relying on the theory of inherency, the examiner must provide a basis in

fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the cited art." *Ex parte Levy* 17 USPQ2d 1461, 1464 (Bd. Pat. Ap. & Inter. 1990) (emphasis in original). Nothing in the disclosure of the cited reference, or any extrinsic evidence of record, establishes that the materials and methods used therein necessarily afford hydrogel foams having an average pore size in the recited range.

In view of the above remarks, it is apparent that the application is in condition for allowance. Therefore, a Notice of Allowability is solicited.

If, in the opinion of the Examiner, a telephone conversation could expedite prosecution, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

  
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I, James H. Meadows, hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on the date April 16, 2003  
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